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In the Supreme Court

OF THE

United States

OCTOBER TERM, 1949

No. 493

GRANAT BROS. (a corporation) and JOSEPH GRANAT,
Petitioners,

vs.

RALPH D. GOMEZ and WILLIAM HENDERSON, as individuals and co-partners doing business under the name of Gomez Manufacturing Company,
Respondents.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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INTRODUCTION.

This action was originally commenced in the District Court for the Northern District of California by respondents against petitioners under Section 274d of the Judicial Code (28 U.S.C.A. Sec. 400) for a

declaratory judgment establishing the invalidity of the Granat Patent No. 2,059,228. Defendants filed a cross-complaint alleging infringement of the patent in suit. The District Court determined the issues in favor of the defendants-petitioners; held the patent in suit valid and infringed; and dismissed the complaint for a declaratory judgment. The United States Court of Appeals for the Ninth Circuit in an opinion rendered Oct. 20, 1949 (177 F. (2d) 266) reversed the District Court and held the patent in suit invalid.

The Granat Patent No. 2,059,228 relates to a mechanically locked finger ring ensemble comprising an engagement ring and a wedding ring together with a dovetail joint which connects the two rings together. The prior art fully discloses the combination of two finger rings held in locked relationship by mechanical means. The particular type of mechanical connecting means used by the patentee to hold his two rings in connected relationship is commonly known as a dovetail joint, and this is also fully disclosed by the prior art. The United States Court of Appeals for the Ninth Circuit correctly held (R. p. 156) that:

> "Granat did not invent nor discover the finger ring ensemble with interlocking relationship; neither did he invent nor discover the dovetail joint. He used the dovetail joint as a means of interlocking the two rings."

THE PETITION FOR WRIT OF CERTIORARI.

Petitioners contend that:

(1) The opinion of the Court of Appeals for the Ninth Circuit holds that in order to have a patentable combination such combination must include a new element which in itself must be the result of invention. It is also contended that the ruling as interpreted and stated by petitioners is in direct conflict with this Court's decision in *Faulkner v. Gibbs,* 70 S.Ct. 25;

(2) The opinion of the Court of Appeals has imposed a new and undue restriction on what constitutes invention under R.S. 4885, 35 U.S.C. Sec. 31.

A DISCUSSION OF POINTS 1 AND 2.

Petitioners have erroneously interpreted the ruling of the Court of Appeals in this case. The decision does not hold that a combination in order to be patentable must include a new element. The statement in the decision that the addition of a new element to an old invention may be patentable providing such new element is the result of invention as distinguished from the exercise of mechanical skill, cannot be interpreted, as petitioners contend, to mean that a new element must be found in a combination in order to make such a combination patentable. The Court of Appeals correctly stated the legal principle controlling here in the last paragraph of its opinion, as follows:

> "In the instant case the interlocking ensemble was well known, and the dovetail joint was well known to the art. No new or unexpected result

was obtained and hence we think the patent invalid for lack of invention."

This Court has repeatedly held that a combination of old elements, where each element performs the same function in its new environment as it performed in its old, and where no new result is obtained by the combination, does not embody patentable novelty. Some of such cases are:

Mast, Foos & Co. v. Stover Mfg. Co., 177 U.S. 485; 44 L. Ed. 856;

Vandenburg v. Truscon Steel Co., 261 U.S. 6; 67 L. Ed. 507;

Altoona v. American et al., 294 U.S. 477, 55 S.Ct. 455; 79 L. Ed. 1005;

Mandel Bros. v. Wallace, 335 U.S. 291, 69 S.Ct. 73;

Jungersen v. Ostby & Barton Co., 335 U.S. 560, 69 S.Ct. 269.

In the present case such prior patents as Thomas No. 1, 536,540, Kaas No. 424,211, and Bullard No. 464,749 disclose two finger rings detachably held together in interlocked relationship by mortise and tenon connecting means. In each of these prior patents the two rings of the ensemble when worn on a person's finger are prevented by the connecting means from independently rotating relative to each other and from becoming detached one from the other. In the patent in suit the two rings of the ensemble are held against relative independent rotation and detachment by a dovetail type of connection or joint. A dovetail type of joint is commonly used in various arts to hold

two elements together, as evidenced by such representative patents as Atkinson 942,047, Tschergi 1,482,772, Kelly 152,233, etc. In the combination of the patent in suit the dovetail joint functions in exactly the same manner as it does in various arts, that is, it holds the two rings or elements in interlocked relationship. It will be noted in applying the legal principles set forth in this Court's decisions above cited as well as others mentioned in the opinion of the Court of Appeals, that since the patentee Granat merely selected a well known type of connecting means to connect his two rings together, he did not invent a patentable combination. (*Mast, Foos & Co. v. Stover Mfg. Co., supra; Mandel Bros. v. Wallace, supra.*) Furthermore, in the opinion of the Court of Appeals it was specifically and correctly stated that to connect two finger rings together by means of a well known connection or joint was not invention but merely the exercise of mechanical skill.

In the *Faulkner v. Gibbs* case, with which petitioners contend the decision of the Court of Appeals is in conflict, the patent was upheld because of the fact of combination rather than the novelty of any particular element. In the instant case the patent in suit was declared invalid by the Court of Appeals because all of the elements of the combination were old, because no new result was obtained by the combination and because there obviously was no invention involved in attaching two finger rings together by an old and well known type of joint or connection. The Court of Appeals in its decision did not rule that a

patentable combination must include a new element, as contended by petitioners. It merely stated that the addition of a new element to an old invention may be patentable providing invention was involved as distinguished from mechanical skill. Certainly there is no conflict between this statement of the law and this Court's ruling in *Faulkner v. Gibbs, supra.* Neither is the law as stated in the present case in conflict with the doctrine set forth in *Cantrell v. Wallick,* 117 U.S. 689, 29 L. Ed. 1017. In that case the patent was upheld because the combination of old elements was found to embody patentable novelty. It was there pointed out that improvements or changes in the construction of old machines might be patentable if the usefulness of such a machine is increased. Here the Granat ring ensemble does not provide any change or improvement over the prior art, nor can it be considered to be more useful than the ring combinations disclosed in Thomas, Bullard and Kaas. In each of the ring combinations of the prior art as well as that of the patent in suit the two rings are held in interlocked relationship by mechanical connecting means which functions to hold them against detachment and independent rotation when worn on a person's finger.

The decision of the Court of Appeals in the present case obviously is not in conflict with either *Faulkner v. Gibbs* or *Cantrell v. Wallick,* nor does it impose a new and undue restriction on what constitutes invention under *R.S.* 4886, *U.S.C.,* sec. 31.

On appeal, a Court of Appeals when convinced that a device shows neither novelty nor invention, may hold

a patent invalid, notwithstanding findings of the trial Court to the contrary. See *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U.S. 477, 55 S.Ct. 455, 79 L. Ed. 1005; *Universal Oil Products Co. v. Globe Oil and Refining Co.*, 322 U.S. 471, 473, 64 S.Ct. 1110, 88 L. Ed. 1399; *Pointer v. Six Wheel Corporation*, 9th Cir., 177 F. (2d) 153, 156.

CONCLUSION.

It is respectfully submitted that petitioners have erroneously interpreted and stated the ruling of the Court of Appeals in the present case; and that when correctly interpreted and stated it does not conflict with this Court's rulings in *Faulkner v. Gibbs* or *Cantrell v. Wallick.*

It is therefore prayed that the petition for a writ of certiorari be denied.

Dated, San Francisco, California,
December 21, 1949.

Respectfully submitted,
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